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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/821,915

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Michael A. Newell

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7590

06/21/2004

MOTOROLA, INC.

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IL01/3RD

SCHAUMBURG, IL 60196

EXAMINER

TRAN, PABLO N

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 06/21/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,915

Applicant(s)

NEWELL ET AL.

Examiner

Pablo N Tran

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,735,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclosed common subject matter such as a method for providing entertainment to a wireless communication device and operating said games based upon predetermined game parameters associated with a location of said wireless communication device.

Claim Rejections - 35 USC § 102

Art Unit: 2685

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6, 11-15, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by *Paulauskas et al.* (6,401,033).

As per claims 1, 11, and 20, *Paulauskas et al.* disclosed a method for providing entertainment to a wireless communication system, wherein providing wireless communication with an entertainment counsel (fig. 1) in said vehicle, receiving location information related to said vehicle, providing challenges associated with a game to a user of said entertainment counsel from a remote network, and providing rewards in response to answers based upon the location of said vehicle (fig. 3, fig. 6-8, col. 4/ln. 64-col. 9/ln. 31).

As per claims 2 and 12, *Paulauskas et al.* disclosed wherein said game is downloaded to said vehicle (fig. 3, fig. 6-8, col. 4/ln. 64-col. 9/ln. 31).

As per claims 3 and 13, *Paulauskas et al.* disclosed receiving a response from the user as the user observes an item near said vehicle (fig. 3, fig. 6-8, col. 4/ln. 64-col. 9/ln. 31).

As per claims 4 and 14, *Paulauskas et al.* disclosed generating a count when the user comes within a specified distance to the item for a specified amount of time (fig. 3, fig. 6-8, col. 4/ln. 64-col. 9/ln. 31).

As per claims 5 and 15, *Paulauskas et al.* disclosed wherein said specified distance comprises a distance enabling the user to read the information contained at a predetermined location (fig. 3, fig. 6-8, col. 4/ln. 64-col. 9/ln. 31).

As per claim 6, *Paulauskas et al.* disclosed wherein said information comprises visually detectable information (fig. 3, fig. 6-8, col. 4/ln. 64-col. 9/ln. 31).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-10 and 16-19 rejected under 35 U.S.C. 103(a) as being unpatentable over *Paulauskas et al.* (6,401,033).

As per claims 7 and 16, *Paulauskas et al.* do not explicitly disclosed wherein said reward is determined by the time of day and amount of time spent at said predetermined location. However, such is notoriously well known in the art that the examiner takes Official Notice of such. Therefore, it would have been obvious to one of ordinary skill in the art to provide such rewarding method, well known, to the

Art Unit: 2685

entertainment system of *Paulauskas et al.* in order to provide an exiting entertainment system to the players.

As per claims 8, 17, and 19, *Paulauskas et al.* do not specifically disclosed multiple vehicles communicating wirelessly to play against each other. However, such is notoriously well known in the art that the examiner takes Official Notice of such. Therefore, it would have been obvious to one of ordinary skill in the art to provide such multiple players entertainment system, well known, to the entertainment system of *Paulauskas et al.* in order to provide an exiting entertainment system to the players.

As per claims 9, *Paulauskas et al.* do not specifically disclosed deducting points based upon an undesirable locations. However, such is notoriously well known in the art that the examiner takes Official Notice of such. Therefore, it would have been obvious to one of ordinary skill in the art to provide such points system, well known, to the entertainment system of *Paulauskas et al.* in order to provide an exiting entertainment system to the players.

As per claims 10 and 18, *Paulauskas et al.* disclosed providing coupons from sponsors of said game based on said answers. However, such is notoriously well known in the art that the examiner takes Official Notice of such. Therefore, it would have been obvious to one of ordinary skill in the art to provide such rewarding method, well known, to the entertainment system of *Paulauskas et al.* in order to provide an exiting entertainment system to the players.

Art Unit: 2685

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Alumbaugh (6,278,938), LaDue (6,285,868), Sporgis (6,320,495), Iwasaki (6,518,967), Taguchi (6,148,253), Khosla (6,080,063), Chang et al. (4,162,792), Stefanik et al. (5,984,311), Wehrley (5,056,798), Ong (WO0105476A1), and Lang (WO0029083A1) disclose entertainment system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)305-4385.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

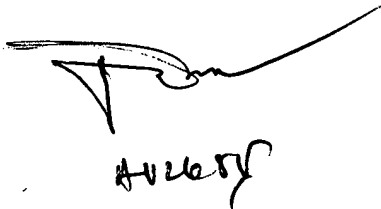
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Art Unit: 2685

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PABLO N. TRAN
PRIMARY EXAMINER

June 11, 2004

A handwritten signature in black ink, appearing to read 'P. Tran', with a stylized flourish extending from the end of the signature.